

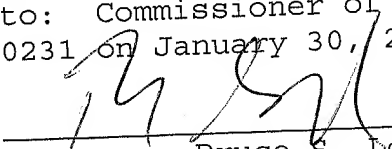
#24 / Petition
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Bruce S. Londa

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney's Docket No.: 101195-4

Examiner : A. Chakrabarti
Group Art Unit : 1655
Serial No. : 08/983,605
Filed : May 1, 1998
Applicant(s) : Marion Roder et al.
For : Microsatellite Markers for Triticum Aestivum
and Species of the Tribe Triticeae

PETITION UNDER 37 CFR 1.144

Box PETITIONS
Hon. Commissioner of Patents
Washington, D.C. 20231

Sir:

This is a petition requesting that an Examiner's final decision on a restriction be overturned in an official action dated August 2, 2001 in the above-referenced application.

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OFFICE OF PETITIONS

Any necessary petition fees should be charged to Deposit Account no. 14-1263.

The Examiner made a restriction final in an official action dated August 2, 2001, stating that a search of 18 additional nucleotides would be an undue burden.

However, Applicants submit that the 10 primer pairs (20 nucleotide sequences) elected and acknowledged by the Examiner in paper no. 15 are not an undue burden, because the Examiner has not provided any rationale for not allowing an election of the 10 elected sequences, except for stating they are patentably distinct.

The Commissioner acknowledged that "sequences...normally constitute independent and distinct inventions". However, the Commissioner has accommodated the biotechnology industry without creating an undue burden on the USPTO by providing for a 'reasonable number of such nucleotide sequences to be claimed'. See MPEP 804.04. This provision for a reasonable number of sequences amounts to a partial waiver of the restriction requirement under 35 U.S.C. 121 and 37 C.F.R. 1.141 et seq. As recited by the Examiner himself in paper no. 20, MPEP 803.04

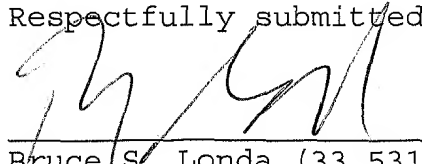
defines 'reasonable number' as being 10 sequences to be examined.

Furthermore, paper no. 14 (Interview Summary) explicitly stated that "the examiner would be willing to examine 10 primer pairs (20 sequences) that Applicant elects."

Therefore, Applicants acknowledge the election of SEQ. ID. Nos 1-2. In addition, Applicants provisionally elect an additional 8 primer pairs, which comprise SEQ. ID. Nos 27, 28; 93, 94; 129, 130; 203, 204; 277, 278; 315, 316; 345, 346; 361, 362; 383, 384; 397 and 398.

Wherefore, applicants respectfully request that the Commissioner order the examiner to allow an election, and subsequent search and examination, of a total of 10 primer pairs to be chosen by the applicants.

Respectfully submitted,



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